

## **REMARKS**

The present application includes pending claims 1-27, all of which have been rejected. By this Amendment, claims 1, 4, 10, 19, 20, and 24 have been amended, as set forth above. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-6, 8, 19, 20, 23, 24, and 27 stand rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 6,656,119 (“Sasaki”). Claims 7, 9, 10-18, 21, 22, 25, and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki in view of United States Patent No. 6,337,481 (“Stearns”). The Applicant respectfully traverses these rejections for at least the following reasons:

### **I. Sasaki Does Not Anticipate Claims 1-6, 8, 19, 20, 23, 24, and 27**

The Applicant first turns to the rejection of claims 1-6, 8, 19, 20, 23, 24, and 27 as being anticipated by Sasaki. “A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in **a single prior art reference.**” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). “The **identical** invention must be shown in as complete detail as is contained in ... the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

#### **A. Sasaki Does Not Describe, Teach, Or Suggest Enabling Imaging Use Of An Imaging System Through Inputting A Biometric Identifier**

As discussed in detail below, Sasaki does not describe, teach, or suggest “wherein a user inputs a biometric identifier into said biometric authorization unit in order to

enable imaging use of the imaging system,” as recited in claim 1, “enabling imaging use of the medical imaging system when biometric data input at the biometric authorization unit matches stored biometric data,” as recited in claim 19, or “enabling audio/video use of the audio/video equipment when biometric data input after said registering matches the stored biometric data,” as recited in claim 24.

Sasaki “relates to a medical imaging diagnostic apparatus such as ultrasonic diagnostic apparatus and a maintenance method of the same, and more particularly to a technique suitable to remote maintenance from a remote computer connected to a medical imaging diagnostic apparatus via a communication line.” Sasaki at column 1, lines 8-12. The Abstract of Sasaki reinforces that Sasaki is related to activating a “maintenance mode” of the apparatus:

A medical imaging diagnostic apparatus is maintained by means of a remote computer connected to a communication line. This maintenance includes: generating log data concerning a use state of a medical imaging diagnostic apparatus; transmitting the thus generated log data to the remote computer via the communication line; storing the thus transmitted log data as data that configures a database on the remote computer; and analyzing the use state of the medical imaging diagnostic apparatus so that the use state can be displayed based on the stored log data.

*Id.* at Abstract.

Sasaki describes a system and method in which a person may gain access to functions relevant to an account, and the individual **settings** of startup, **but not imaging use of a system:**

According to a fourth aspect of the present invention, there is provided an **apparatus connected to a network** with wire or wirelessly. This apparatus has functions or the like

used for any other purpose than diagnosis such as repair, fault diagnosis, periodic inspection, for example, functions for providing access via a network connected with wire or wirelessly, thereby controlling an operation of the apparatus, storing into the apparatus the internal state of the apparatus, and acquiring information/data obtained. This apparatus comprises means for automatically setting access privileges of these functions in accordance with predetermined procedures. The means can include startup switch means, pointer means, voice startup selection means or the like.

According to the fourth aspect, there can be provided a configuration in which, of the functions of the apparatus relevant to an account capable of accessing the foregoing functions, the individual settings of startup enable or disable are provided in the apparatus or over only a network to which the apparatus belongs with respect to a function for providing access to the hospital internal information or patient information in the apparatus and in a network to which the apparatus belongs.

According to a fifth aspect of the present invention, there is provided an ultrasonic diagnostic apparatus connected to a network, comprising functions for providing access any other purpose than diagnosis such as apparatus repair, fault diagnosis, or periodic inspection; controlling an operation of the apparatus, and/or storing the internal state or the like of the apparatus in the apparatus, and/or acquiring information/data obtained, a pointer for automatically enabling/disabling these functions in accordance with predetermined procedures; or a switch containing startup selection by voice.

*Id.* at column 4, line 59 to column 5, line 23.

The “fourth aspect” of Sasaki include “means for automatically setting access privileges” for the following: repair, fault diagnosis, periodic inspection, such as functions for providing access via a network connected with wire or wirelessly, thereby controlling an operation of the apparatus, and acquiring information/data obtained. Note,

“such as,” as used in column 4, line 59 to column 5, line 23, is used to further discuss what “periodic inspection” means.

The “fifth aspect” of Sasaki includes “functions for providing access any other purpose than diagnosis such as apparatus repair, fault diagnosis, or periodic inspection; controlling an operation of the apparatus, and/or storing the internal state or the like of the apparatus in the apparatus, and/or acquiring information/data obtained, a pointer for automatically enabling/disabling these functions in accordance with predetermined procedures; or a switch containing startup selection by voice.”

These portions of Sasaki do not relate to “enabling imaging use of the imaging system.” As noted above, Sasaki is concerned with “maintenance” of the system. See Sasaki at, e.g., Abstract and column 1, lines 8-12. Sasaki is, however, completely silent with respect to “enabling imaging use of the imaging system.” Just because Sasaki allows one to access repair, fault diagnosis, or even controlling the operation of the apparatus through a network, does not preclude the apparatus from being enabled for imaging use. That is, while maintenance operation of the system of Sasaki may be controlled through a network, there is nothing in Sasaki that precludes a user from enabling imaging use of the system. There simply is nothing in Sasaki that would preclude imaging use of the imaging system separate from the network.

Sasaki continues by stating the following:

According to the above fourth and fifth aspects, one of the following configurations is possible.

\* \* \*

8) User recognition means for supervising physiological

characteristics of individuals registered in advance can be provided. In this case, the physiological characteristics include fingerprint, iris pattern, voiceprint, and facial characteristics, for example.

*Id.* at column 5, lines 24-58. Thus, Sasaki describes a system and method in which user recognition means for supervising physiological characteristics of individuals registered in advance can be provided. Sasaki does not describe, teach, or suggest, however, that these physiological characteristics are used to “enable imaging use of an imaging system.” Again, just because a network may be in communication with imaging equipment, does not mean that use of the imaging equipment can only be enabled through communication with that network. Sasaki simply does not describe, teach, or suggest “a biometric authorization unit in electrical communication with said central processing unit, wherein a user inputs a biometric identifier into said biometric authorization unit in order to enable use of the imaging system,” as recited in claim 1 of the present application.

The Applicant further notes that Figure 12 of Sasaki, which the Office Action relies on, is a “view illustrating an example applied in the case of **remote diagnosis** in the second embodiment of the present invention,” while Figure 13, which the Office Action also relies on, is a “schematic block diagram illustrating a medical imaging diagnostic apparatus and a maintenance method of the same according to a third embodiment of the present invention.” Sasaki at column 8, lines 33-39. Neither of these relates to “enabling use of the imaging system” through the input of a biometric identifier. Indeed, Figure 13 even depicts a “login screen” that requires input of an

operator name and a password, instead of a biometric identifier, in order to enter a maintenance mode.

Sasaki does not describe, teach or suggest the following:

- “a biometric authorization unit in electrical communication with said central processing unit, wherein a user inputs a biometric identifier into said biometric authorization unit **in order to enable imaging use of the imaging system,**” as recited in claim 1;
- “a biometric authorization unit, wherein a user inputs a biometric identifier into said biometric authorization unit **in order to use the medical imaging device to image a patient,**” as recited in claim 10;
- “**enabling imaging use of the medical imaging system** when biometric data input at the biometric authorization unit matches stored biometric data,” as recited in claim 19; or
- “**enabling audio/video use of the audio/video equipment** when biometric data input after said registering matches the stored biometric data,” as recited in claim 24.

Thus, for at least these reasons, Sasaki does not anticipate, or render unpatentable, claims 1, 10, 19, 24, or the claims that depend therefrom.

#### **B. Sasaki Does Not Anticipate Claim 2**

Claim 2 of the present application recites the following:

The imaging system of claim 1, wherein biometric data extracted from the biometric identifier is compared with stored biometric data in said data storage unit, wherein the stored biometric data is associated with stored personal

identification information, and wherein the stored biometric data and the stored personal information are stored after an initial registration.

This claim should be in condition for allowance for at least the reasons discussed above.

Additionally, the Office Action cites Sasaki at column 7, lines 5-31 as support for “wherein biometric data extracted from the biometric identifier is compared with stored biometric data in said data storage unit.” *See* October 31, 2006 Office Action at page 4.

As shown below, however, this portion of Sasaki does not even describe, teach or suggest biometric data, or a biometric identifier:

A medical imaging diagnostic apparatus according to the present invention comprises: log generating means for generating log data concerning a use state of a medical imaging diagnostic apparatus; log recording means for recording the log data generated by the log generating means on a predetermined medium; and analysis means for analyzing the use state of the medical imaging diagnostic apparatus so that the use state can be displayed based on the log data recorded on the recording medium by the log recording means.

A medical imaging diagnostic apparatus according to the present invention comprises: input means configured so as to **enable maintenance** by means of a remote computer connected via a communication line, the input means being provided at the medical imaging diagnostic apparatus, the input means being adopted to input information concerning a system user; operating means provided at the medical imaging diagnostic apparatus, operating means being adopted to instruct change to a **predetermined system maintenance mode**; transmission means for, when a change to the system maintenance mode is instructed by the operating means, transmitting information concerning the system user inputted by the input means and date and time information to the remote computer; and means for switching a current state into a state for enabling at least one of system diagnosis of the medical imaging diagnostic apparatus, system setting change thereof, and control

program change based on a signal transmitted from the remote computer via the communication line in response to the information transmitted by the transmission means.

Sasaki at column 7, lines 5-31 (emphasis added). The Applicant initially notes that this portion of Sasaki relates to a “maintenance mode.” As shown above, there is no mention of any biometric data, identifier, or the like within this passage of Sasaki. There is nothing in this portion of Sasaki that describes, teaches, or suggests “wherein biometric data extracted from the biometric identifier is compared with stored biometric data in said data storage unit,” as recited in claim 2.

The Office Action also cites column 14, lines 7-13 as support for “wherein the stored biometric data is associated with stored personal identification information.” *See* October 31, 2006 Office Action at page 4. This portion of Sasaki states, however, the following:

In addition, the thus obtained data concerning the use state of the ultrasonic diagnostic apparatus can be associated with **data concerning patient's diseases** additionally obtained (such as liver dysfunction, stone or pancreatitis) each other. In this case, the above described effect can be improved more significantly, for example, by comparing/evaluating the examination time of each mode by each patient's disease.

Sasaki at column 14, lines 7-13. “Data concerning patient’s diseases” is not a “biometric identifier” that is input to “enable use of an imaging system.” Further, “data concerning patient’s diseases” is not “personal identification information.” There is nothing in this passage of Sasaki that describes, teaches, or suggests “wherein the stored biometric data is associated with stored personal identification information,” as recited in claim 2.

The Office Action also cites column 21, line 62 to column 22, line 15 of Sasaki as support for “wherein the stored biometric data and the stored personal identification information are stored after an initial registration.” *See* October 31, 2006 Office Action at page 4. This portion of Sasaki states the following:

In contrast, according to the present embodiment, in particular, with respect to a case in which preferred operating environment is provided to each operator or a function concerning security or the like of the ultrasonic diagnostic apparatus 100, for example, a restriction applies to functions available for use according to service personnel, administrator or general operator. **In this way, a user name and a password is requested during startup of the ultrasonic diagnostic apparatus 100, during logon,** or during operator change so that only privileged functions can be used from a use privilege assigned to a user registered in advance in the apparatus. Thus, the function use privileges according to the user levels are divided, and the security of the ultrasonic diagnostic apparatus 100 can be ensured more reliably as compared with a conventional example.

An operator such as an administrator can generate a use privilege as required. In this case, there can be employed a technique of generating a new privilege level and assigning the use privilege of a function corresponding to such privilege level. In addition, a new privilege level can be assigned during operator registration.

Sasaki at column 21, lines 62 to column 22, lines 15 (emphasis added) Again, though, there is nothing in this portion of Sasaki that describes, teaches, or suggest “biometric data.” Indeed, this portion of Sasaki specifically states that a “user name and a password are requested during startup.” There is nothing in this portion of Sasaki that describes, teaches, or suggests “wherein the stored biometric data and the stored personal identification information are stored after an initial registration,” as recited in claim 2.

Thus, Sasaki does not anticipate claim 2 for at least the reasons discussed above.

**C. Sasaki Does Not Anticipate Claims 3 And 20**

Claim 3 of the present application recites the “imaging system of claim 2, wherein user preference information is associated with the stored biometric data and with the personal identification information.” This claim should be in condition for allowance for at least the reasons discussed above with respect to claims 1 and 19.

Additionally, the Office Action cites Sasaki at column 22, line 15 to reject claim 3. That portion of Sasaki, as reproduced above, does not even relate to biometric data. Column 22, line 15 of Sasaki, moreover, states the following: “In addition, a new privilege level can be assigned during operator registration.” Nothing in Sasaki at column 21, line 62 to column 22, line 15 describes, teaches, or suggests, “wherein user preference information is associated with the stored biometric data and with the personal identification information,” as recited in, for example, claim 3. Thus, for at least these reasons, Sasaki does not anticipate claims 3 and 20.

**D. Sasaki Does Not Anticipate Claim 4**

Sasaki does not anticipate claim 4 for at least the reasons discussed above with respect to claim 1. Moreover, Sasaki does not describe, teach, or suggest, “wherein imaging use of the imaging system is allowed when a match exists between the biometric data extracted from the biometric identifier and the stored biometric data.” Thus, for at least these reasons, Sasaki does not anticipate claim 4.

**E. Sasaki Does Not Anticipate Claim 27**

Claim 27 recites the “method of claim 24, wherein the audio/video equipment is one of a television, camera, CD players, DVD player, and car stereo.” Sasaki does not anticipate this claim for at least the reasons discussed above with respect to claims 1 and 24.

Additionally, Sasaki does not describe, teach, or suggest any of the components listed in claim 27. The Office Action cites reference numeral 125 as a television. *See* October 31, 2006 Office Action at page 5. Reference numeral 125 is a “DSC,” however, but not a television. Further, reference numeral 113 is a computer monitor, but not a television. Additionally, there is nothing in column 9, lines 10-44, or column 5, lines 25-62 of Sasaki (as cited by the Office Action) that describes, teaches, or suggests a “television, camera, CD player, and car stereo,” as recited in claim 27. Thus, for at least these reasons, Sasaki does not anticipate claim 27.

**II. The Proposed Combination Of Sasaki And Stearns Does Not Render Claims 7, 9-18, 21, 22, 25, And 26 Unpatentable**

The Applicant next turns to the rejection of claims 7, 9-18, 21, 22, 25, and 26 as being unpatentable over the proposed combination of Sasaki in view of Stearns. The proposed combination does not render these claims unpatentable for at least the reasons discussed above.

Additionally, the Applicant submits that a *prima facie* case of obviousness has not been established with respect to any of these claims. In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (MPEP) states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Manual of Patent Examining Procedure MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

*See* Manual of Patent Examining Procedure MPEP at § 2142.

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is **not** whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP at § 2141.02. The law is well settled that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984). It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather "some teaching or suggestion in the references to support

their use in the particular claimed combination" is needed. *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

In *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). **It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious.** That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

*Ex parte Hiyamazi*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988) (emphasis added).

In rejecting claims 7, 9-18, 21, 22, 25, and 26 as being unpatentable over the proposed combination of Sasaki and Stearns, the Office Action does not even cite where the missing limitations of Sasaki are found in Stearns. See October 31, 2006 Office Action at pages 5-7. Instead, the Office Action makes broad conclusory statements with no citations from the references. Thus, for at least this reason, the Office Action does not establish a *prima facie* case of obviousness with respect to claims 7, 9-18, 21, 22, 25, and 26.

Further, the Office Action does not articulate a proper motivation to combine the references. As noted above, the Office Action does not even cite portions of the references where the limitations are supposed to be found. In terms of a motivation to combine, the Office Action makes a blanket generalization that is intended to sweep in all of the limitations recited in claims 7, 9-18, 21, 22, 25, and 26, as shown below:

Based on the above observations, for a person of ordinary skill in the art, modifying the system disclosed by Sasaki et al., with the above discussed enhancements would have been considered obvious because such modifications would provide remote services to the imaging system, transmitting and receiving imaging data via a network to a remote facility.

*See* October 31, 2006 Office Action at page 7. The Office Action not address each separate claim. Instead, the Office Action merely makes an overly broad statement that the various claim limitations recited in claims 7, 9-18, 21, 22, 25, and 26 are obvious because of the “above discussed enhancements.” As noted above, however, the Office Action does not even attempt to show where in the references the “enhancements” are found.

Moreover, merely identifying isolated elements in the prior art is not enough to establish a *prima facie* case of obviousness, as shown below:

[M]ere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. [*In re Rouffet*, 149 F. 3d 1350] at 1355, 1357 [(Fed. Cir. 1998)]. Rather, to establish a *prima facie* case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. *Id.* In practice, this **requires** that the Board “explain the reasons one of ordinary skill in the art would have been motivated

to select the references and to combine them to render the claimed invention obvious.” *Id.* at 1357-59. This entails consideration of both the “scope and content of the prior art” and “level of ordinary skill in the pertinent art” aspects of the Graham test.

**When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious.** *Id.* at 1358.

*See in re Kahn*, 441 F.3d 977 (Fed. Cir. March 22, 2006) (emphasis added).

In this case, the Office Action attempts to show a motivation to combine through “enhancements” that are supposedly found in the references. As noted above, the Office Action does not even attempt to direct the Applicant to where these “enhancements” are supposedly found. The mere identification of “enhancements” to provide a motivation to combine, however, is not enough to establish a *prima facie* case of obviousness. In short, a *prima facie* case of obviousness cannot be established through unsupported broad statements regarding “enhancements,” and then jumping to the unsupported conclusion that such “enhancements” are obvious because of the benefits of such “enhancements.” Thus, for at least this reason, the Office Action has not established a *prima facie* case of obviousness with respect to claims 7, 9-18, 21, 22, 25, and 26.

### **III. Conclusion**

The Applicant respectfully submits that the pending claims of the present application should be in condition for allowance for at least the reasons discussed above. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the Applicant. The Commissioner is authorized to charge

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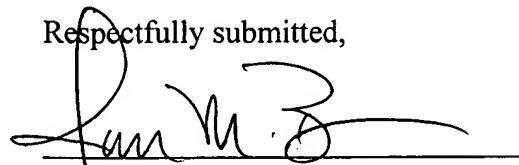
Docket No. 138065UL (MHM 15115US01)

any necessary fees, or credit any overpayment to the Deposit Account No. 07-0845.

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